

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 August 2009 has been entered.

Withdrawal of Claim Rejection under 35 USC § 101

2. The previous rejection under 35 USC § 101 was overcome by amending each independent method claim 1, 56, 60, 69, 71, 75 and 81 to "determining/generating, by a controller device" a list, indication, etc. That is supported at para. [0092] of the published application (US 20020165771A1).

Applicability of 35 USC 112, 6th Paragraph

3. It appears the applicant is attempting to invoke 35 U.S.C. 112, 6th paragraph in claims 93, 95, 104 and 106 by using "means-plus-function" language, such as "means for sending", which has no apparent support in the specification. In order to successfully invoke the sixth paragraph, a three-prong test must be met (MPEP § 2181.I): (1) the claim must use means-plus-function language; (2) the claim itself must not provided structural limitations to the means-plus-function language; and (3) the specification must recite explicit physical structural limitations for the means-plus-function language in the claim.
4. While the above claims pass the first two prongs of the three prong test, they do not pass the third prong: There is no explicit recitation in the specification of any physical structures to perform the functions of the means-plus-function limitations in the claims. Therefore, 35 U.S.C 112, 6th paragraph has not been successfully invoked. The Examiner will consider the means to perform the claimed functions as any means, physical or virtual, that can perform the function.

Claim Rejections - 35 USC § 112

5. The following rejection was inappropriate (because the subject language is supported at para. [0042] and claim 82 in the published application, US 20020165771A1) and is hereby withdrawn.

“10. Claims 1, 4, 8, 9, 13, 15-25, 28-34, 36, 37, 39-64, 69-75, 81 and 92-106 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In every independent claim, either “a subsidizer that is ... not a direct party to the first transaction” (e.g., claim 1 lines 11-12) or “a third party entity that is neither ... the restaurant and is not a direct party to the first transaction” (e.g., at claim 69, lines 11-13) is new matter.” (Para. 10 of the Office action mailed 26 February 2009).

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 4, 8, 9, 13, 15-25, 28-34, 36, 37, 39-64, 69-75, 81 and 92-106 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In every independent claim, either “a/at least one subsidizer that is neither the customer nor the at least one merchant” (e.g., claim 1 lines 11-12) or “a third party entity that is neither the customer nor the restaurant” (e.g., at claim 69, lines 11-12) is indefinite.
8. The distinction between “subsidizer” and “customer” is not at issue because these terms identify distinct functions. Even if the “customer” is a corporation, it must be inherently different from a “subsidizer” because no person or corporation can provide a subsidy to itself.
9. However, there is no such sharp distinction between a subsidizer and the at least one merchant. Unlike the “customer”, a merchant can also be a subsidizer. While a merchant

Art Unit: 3688

could of course not be a subsidizer, that limitation is indefinite because “merchant” is a business entity inherently defined by ownership, and therefore variable.

10. The US Supreme Court has ruled that “A corporation is an artificial being, invisible, intangible and existing only in contemplation of law.” *CTS Corp. v. Dynamics Corp. of America*, 481 U.S. 69, 89, 107 S. Ct. 1637, 1649-1650 (1987) (citing *Trustees of Dartmouth College v. Woodward*, 17 U.S. (4 Wheat) 518 (1819)). A business entity is variable because it can be created, merged, dispersed or destroyed at human whim. Hence, in accordance with the *State Street* decision (MPEP 2106.II.A), ownership language cannot impart patentability. See also MPEP § 2173.05(b), “REFERENCE TO AN OBJECT THAT IS VARIABLE MAY RENDER A CLAIM INDEFINITE”. The problem is the same for “a third party entity that is neither the customer nor the restaurant” since a restaurant is a kind of business. The claimed distinction between “a third party” and “the restaurant” is inherently indefinite.

Claim Rejections - 35 USC § 102 and 35 USC § 103

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3688

13. Claims 1, 4, 8, 9, 13, 15-18, 20-23, 28-34, 36, 37, 39-64, 69-71, 75, 81 and 92-106 are rejected under 35 U.S.C. 102(e) as being anticipated Chen et al. (US006741969B1).

14. Chen et al. teaches (independent claims 1, 56, 60, 69, 71, 75, 81 and 92-95) a method, product and system/apparatus for adjusting prices of one or more items, particularly at a restaurant, the method (as represented by claim 1) comprising:

providing an indication of a plurality of products (*menus*, col. 9 lines 48-52) each of said plurality of products having an initial price (*the amount to be charged*, col. 7 lines 5-6) and being associated with at least one merchant (*a restaurant*, col. 1 lines 44-51);

providing an indication of an available price adjustment (*the incentive*, col. 7 lines 5-6);

determining, by a controller device in electronic communication with at least one customer device (*Account module 650*, col. 16 lines 44-51), a subsidy offer (*the incentive*, col. 7 lines 5-6, or *promotions*, col. 20 lines 3-4) associated with said price adjustment, said subsidy offer including at least one qualifying action that a customer must agree to perform to receive the price adjustment (paying for the meal) on a purchase of at least one of the plurality of products in a first transaction (again, paying for the meal), and wherein the subsidy offer is associated with a subsidizer/third party (*manufacturers or suppliers*, col. 20 lines 4-5) that is neither the customer nor the at least one merchant/the restaurant;

providing, by the controller device (*Account module 650*, col. 16 lines 44-51), an indication of the subsidy offer (*the incentive*, col. 7 lines 5-6, or *promotions*, col. 20 lines 3-4) associated with said price adjustment,

receiving an acceptance of the subsidy offer (the customer orders the *competitor* bottle of wine, col. 20 lines 12-13); and

providing the price adjustment to the customer for the purchase of at least one of the plurality of products in the first transaction (col. 7 lines 5-6).

For claims 71 and 81, Chen et al. also teaches a customer using a wireless device (col. 20 lines 58-60), which inherently operates in a restaurant and inherently for “a plurality of items” when reserving for two or more people. Chen et al. also teaches a yield management system (col. 20 line 32 *et seq.*), which inherently requires a customer in one busy restaurant with a wireless device to use said wireless device to find a less busy restaurant with an incentive (col. 20 line 43).

Art Unit: 3688

For claim 75, Chen et al. also teaches presentation of a payment means (col. 7 lines 1-5 and 6-11), which reads on receiving an indication of a commitment to complete said qualifying action.

15. The following claim language is non-functional descriptive material and was not given patentable weight (MPEP § 2106.01):

“and the qualifying action concerns a purchase of a product of the subsidizer in a second transaction that is not the first transaction”.

The application does not disclose qualifying action “concerns”, so the examiner is required to give this claim language its broadest reasonable interpretation in view of one of ordinary skill in the art.¹ The examiner interprets the claim language to mean that the qualifying action (paying for the meal) means that the customer is satisfied with the meal and is therefore *intent* on someday purchasing another meal, which reads on “a product of the subsidizer in a second transaction that is not the first transaction”. A customer’s *intent* is not functional because it does not alter how the process steps are to be performed to achieve the utility of the invention.

16. Chen et al. also teaches at the citations given above claims 4, 8, 9, 13, 15 (the “second price” is the *amount to be charged* minus the *incentive*), 28-32, 34, 37, 39-52, 53 (inherently), 54, 55 (inherently) and 70.
17. Chen et al. also teaches: claim 16 (when the auction expires, col. 2 line 24); claims 17, 18, 20-23, 33 and 36 (col. 19 lines 30-32 and col. 6 lines 61-62 for claim 22); and claims 57-59 and 61-64, where responding to an ad (col. 8 lines 53-55) reads on a qualifying action.
18. Claims 96-106 add only nonfunctional descriptive material and were accordingly not given patentable weight [MPEP 2106.IV.B.1(b)].
19. Claims 19, 24, 25 and 72-74 are rejected under 35 U.S.C. 103(a) as being obvious over Chen et al. (US006741969B1). Chen et al. does not teach verification. Because verification is common sense (“measure twice, cut once”) and easy to achieve (Waiter, will I get the

¹ Unless a term is given a “clear definition” in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111).

Art Unit: 3688

discount if I order this item?), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add price verification to the teachings of Chen et al.

Response to Arguments

20. Applicant's arguments filed with an amendment on 26 August 2009 have been fully considered and considered in the revised rejection given above.

Conclusion

21. This is a continuation of applicant's earlier Application No. 09850328. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
22. The examiner notes further that the present is the seventh rejection, and it is little changed from the first rejection in March 2006. If applicant continues to believe the claims constitute a patentable invention, it would behoove the applicant to appeal this rejection to the BPAI.
23. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached Monday to Wednesday and Friday. The examiner can also be contacted by e-mail at douald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

Art Unit: 3688

25. The examiner's supervisor, Robert Weinhardt, can be reached on 571-272-6633.
26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
27. **AFTER FINAL INTERVIEW PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence in an interview request (form PTOL-413A) that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
28. Applicant may have after final arguments considered and amendments entered by filing an RCE.
29. Applicant is advised that, unless a proposed amendment is filed after final and the examiner returns an advisory action with block 3(a) checked (signifying that further search or consideration is required), an amendment filed with an RCE **COULD BE MADE FINAL IN THE FIRST ACTION** in accordance with MPEP § 706.07(b).

23 October 2009

/Donald L. Champagne/
Primary Examiner, Art Unit 3688